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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,845	02/13/2002	Anna Ericsson	CT2605 NP	9030
23914	7590	12/23/2003	EXAMINER	
STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			ZUCKER, PAUL A	
		ART UNIT		PAPER NUMBER
		1621		
DATE MAILED: 12/23/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	10/075,845	ERICSSON ET AL.
	Examiner Paul A. Zucker	Art Unit 1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) 4,6-9 and 13-20 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3 and 5 is/are rejected.

7) Claim(s) 10-12 is/are objected to.

8) Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Current Status

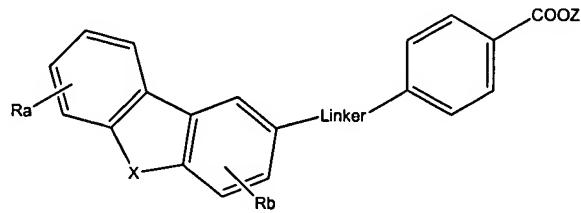
1. This action is responsive to Applicants' Response of 14 October 2003 in Paper No 6.
2. Receipt and entry of Applicants' Response is acknowledged.
3. Claims 1-20 are pending.
4. Claims 4, 6-9 and 13-20 are held withdrawn from consideration

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5. Claims 1-3 and 5 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Akasaki et al (US 5,075,487 12-1991).

Instantly claimed are compounds of formula I:



where the variable groups are as defined in claim 1.

Akasaki teaches (Column 1, line 10- column 2, line 4) fluorene derivatives which have useful properties as electron transport materials for use in multilayered electrophotographic photoreceptors. Akasaki exemplifies (Column 7, line 29 – Column 8, line 16, Example 3) three compounds which correspond to isomers of compounds of the invention in which Linker = C₂ alkenyl, Z= C₄H₉, R_{a,b} = H, X=

$C(R_1)_2$ or CO, $R_1 = H$. These compounds are intermediates in the synthesis of the electron transport materials.

The compounds exemplified by Akasaki differ from those instantly claimed only in that they are isomeric in the attachment of the linker to the aromatic ring.

Akasaki, however, further generically teaches (Column 1, line 56 – Column 2, line 4) that the final product in all its isomeric forms has utility as an electron transport material.

One of ordinary skill in the art would therefore have been motivated to make the instantly claimed isomers by the expectation that they could be used to produce the corresponding isomeric electron transport materials. There would have been a reasonable expectation of success based upon the expectation of similar properties for isomers about an aromatic ring. This expectation would have been reinforced by Akalsaki's generic teaching. The instantly claimed compounds would therefore have been obvious to one of ordinary skill in the art.

Examiner's Response to Applicants' Remarks with Regard to this Rejection

6. Applicants have argued that the disclosure of Akasaki does not constitute analogous art since Akasaki teaches only their use in the synthesis of electrophotographic photoreceptors and does not suggest their utility in cancer treatment. The Examiner responds by pointing out that the ultimate utility of the compounds is not at issue, only whether one of ordinary skill in the art would have been motivated to make the instantly claimed compounds. The fact that Applicants have recognized another

advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Claim Objections

7. Claims 10-12 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Claims 1-20 are pending. Claims 1-3 and 5 are finally rejected. Claims 10-12 are finally objected to. Claims 4, 6-9 and 13-20 are finally withdrawn from consideration.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

This application contains claims 4, 6-9 and 13-20 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker, Ph. D.
Patent Examiner
Technology Center 1600



Johann Richter, Ph.D., Esq.
Supervisory Patent Examiner
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